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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,392	07/08/2003	Kazuhiro Kamiya	B-5147 621066-1	9785
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LADAS & PARRY 5670 WILSHIRE BOULEVARD, SUITE 2100 LOS ANGELES, CA 90036-5679			EXAMINER SAINDON, WILLIAM V	
			ART UNIT 3623	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/616,392	Applicant(s) KAMIYA, KAZUHIRO	
	Examiner WILLIAM V. SAINDON	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/23/03; 1/30/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following NON FINAL Office Action is in response to Applicant's submission received July 8, 2003. Claims 1-11 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of the claim is unclear because it is not certain what is being calculated. Because the claim was not originally written in English, the meaning has been lost in translation. Is a number of times counted after a certain time? Is a number of times counted whenever the reproduction takes a certain length of time? Is a number of times counted up to a certain time? Is "period of time" a certain date or date range? What does "reproduced" mean? Copied? Played? For purposes of examination, the Examiner will construe this limitation to mean --wherein the calculation means is configured to calculate the number of times the recorded information is copied after a certain date.--

4. Claims 7-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are unclear because it is unclear if they are intended to be independent or dependent claims, and it is unclear as to which statutory class they belong, as they contain two statutory classes in each.

5. Although Applicant uses "means for" in the claims, it is the Examiner's position that the "means for" phrases do not invoke 35 U.S.C. §112 6th paragraph. If Applicant concurs, the Examiner respectfully requests Applicant to either amend the claims to remove all instances of "means for" from the claims, or to explicitly state on the record why 35 U.S.C. §112 6th paragraph should not be invoked.

Alternatively, if Applicant desires to invoke 35 U.S.C. §112 6th paragraph, the Examiner respectfully requests Applicant to expressly state their desire on the record. Upon receiving such express invocation of 35 U.S.C. §112 6th paragraph, the "means for" phrases will be interpreted as set forth in the Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6¶. (Federal Register Vol. 65, No. 120, June 21, 2000.)

Failure by Applicant in their next response to address the 35 U.S.C. 112 6th paragraph issues in accordance with 37 C.F.R. §1.111 (b) or to be non-responsive to this issue entirely will be considered a desire by Applicant NOT to invoke 35 U.S.C. §112 6th paragraph. Unless expressly noted otherwise by the Examiner, the preceding discussion on 35 U.S.C. §112 6th paragraph applies to all examined claims currently pending.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Marconcini et al. (US 6,834,110) (hereinafter Marconcini).

As to claim 1, Marconcini discloses:

a plurality of terminals each configured to record one or more pieces of information and to reproduce the recorded information (see Fig. 1D, noting end user device 109 is configured to receive and play media); and

a server system communicably connected with the plurality of terminals via communication means and configured to perform statistic processing on a reproduced condition of the recorded information at the terminals (see Fig. 1D, noting content hosting sites are connected with the terminals; col. 11, lines 4-12, noting that the clearinghouse, connected to the terminals, keeps transaction data from which statistics can be performed),

wherein each terminal comprises

calculation means configured to calculate reproduction-frequency information, every piece of the one or more pieces of recorded information, depending on the

reproduced condition of each of the one or more pieces of recorded information (see col. 90, lines 24-67, noting the player logs usage of the content),

information memorizing means configured to memorize the calculated reproduction-frequency information (see id., noting the player stores the usage information),

reproduction-frequency information request receiving means configured to receive from the server system a request for the reproduction-frequency information (see col. 90, lines 24-67, noting the player sends usage data to the server), and

terminal transmission means configured to transmit the memorized reproduction-frequency information to the server system (see id., noting the player can talk to the server); and

wherein the server system comprises

information request means configured to request a certain terminal for the reproduction-frequency information (see col. 90, lines 24-67, noting the player sends the data to the server, therefore the server must be able to request the data),

reproduction-frequency information receiving means configured to receive the reproduction-frequency information from the terminal (see id., noting the server receives the usage data), and

statistic processing means configured to perform the statistic processing based on the received reproduction-frequency information (see id., noting the server tracks usage by a statistic n, indicating the number of uses).

As to claim 2, Marconcini discloses each of the terminals comprises

identification sign request means configured to, in cases where it is impossible for the terminal to identify a piece of recorded information, transmit, to the server system, characteristic data extracted from the recorded information and to request the server system for an identification sign to identify the recorded information (see col. 60, noting that automatic metadata extraction is well known), and

identification sign receiving means configured to receive from the server system the identification sign of the recorded information (see col. 60, noting that the metadata is received), and

wherein the server system comprises

identification sign request receiving means configured to receive from a certain terminal the identification sign request means as well as the characteristic data (see col. 60, noting that the metadata comes from a server),

recorded-information determining means configured to determine whether or not the received characteristic data is the same as characteristic data corresponding to recorded information previously registered by making comparison between both of the characteristic data (see col. 60), and

identification sign transmitting means configured to transmit to the terminal an identification sign corresponding to registered record information about characteristic data which has been determined to be the same as the received characteristic data (see col. 60),

wherein the terminal transmission means is configured to transmit to the server system the identification sign corresponding to the reproduction-frequency information as well as the memorized reproduction-frequency information (see col. 60), and

the reproduction-frequency information receiving means is configured to receive from the terminal the identification sign corresponding to the reproduction-frequency information as well as the reproduction-frequency information (see col. 60).

As to claim 3, Marconcini discloses wherein the calculation means is configured to calculate the number of times the recorded information is copied after a certain date (see col. 61, lines 29-51, noting that usage conditions are tracked, such as the number of copies allowed to be made as of the date of purchase).

As to claim 4, Marconcini discloses the terminal transmission means is configured to transmit only reproduction-frequency information indicative of a frequency higher than a reference frequency previously determined (see col. 61, lines 29-51, noting that there is a maximum number of times the content can be used).

As to claim 5, Marconcini discloses the recorded information includes information indicating sound (see col. 61, lines 60-67, noting the content can be songs).

Claims 6-11 are rejected for similar reasons as claim 1 as they recite systems, methods, or computer-readable media containing the same or similar elements.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892, noting that usage tracking is generally well-known, as well as using such data for marketing trend analysis.

van Zoest et al. (US 6,496,802) disclose a DRM system.

Rouchon (US 2001/0025259) discloses a system that tracks playing of songs to determine a rank of that song.

Yamane et al. (US 7,092,900) disclose the collection of use frequency of media items.

Quinn et al. (US 2003/0135513) disclose the collection of music information from user access to determine an automatic user playlist based on the user's preferences.

Roberts et al. (US 6,330,593) disclose a client sending use demographic data and cd status to a url server for information gathering.

Treffers et al. (US 2002/0078181) disclose tracking of user's music purchasing habits.

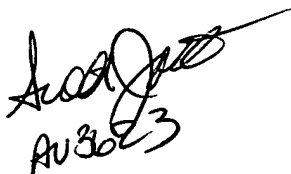
Fritsch (US 6,233,682) disclose purchase of music online with DRM.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM V. SAINDON whose telephone number is (571)270-3026. The examiner can normally be reached on M-F 7:30-5; alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/wvs/


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